

REMARKS

Claims 1-18 are pending in this application. Claims 1-18 are rejected. No new subject matter has been added. No claims have been amended. Claims 1-18 remain pending. Reconsideration of the claims is requested in light of the following remarks.

Claim Objections

Claims 1 is objected to because "upon failure to successfully transmit all of the pages of the fax document to the recipient fax machine, transmitting failed fax pages, defined by those fax pages of the fax document that failed to be successfully transmitted to the recipient fax machine, in the form of a secondary email message, comprising secondary email packets, to the mail server for future retransmission of the failed faxed pages to the recipient fax machine." is not clearly taught how to do with failed fax pages.

The third full paragraph on page 5 of the application describes an embodiment where a mail server is in communication with a router through a packet switched network and furthermore that they are in email contact and the router receives emails from the mail server and converts the information in the email into fax information. In subsequent paragraphs, the present embodiment saves envelope information at the router, the envelope information such as destination information from an email message, including the recipient in the "To:" field. In the last full paragraph on page 6, a secondary email message is sent from the router to the mail server upon a failure of fax-converted email messages to a fax machine.

The current embodiment then states that the packets of the secondary email message will "only be those that were not sent, as fax pages, to recipient fax machines." There are numerous other examples in the detailed description that define this limitation. See also the last full paragraph on page 7 through the fourth paragraph on page 8, the first full paragraph on page 9, and the last full paragraph on page 10 through the first full paragraph on page 11, as examples.

Claims 7 and 18 are objected to because: "transmitting one or more of the first email message packets to the mail server for future re-transmission thereof to the recipient fax machine." is not clear how the first email message packets that is for the future re-transmission when the first email message packets fails to success transmit as claim invention. Regarding the objection for the limitation in claims 7 and 18, the Examiner is respectfully referred to at least the three example sections in the previous paragraph.

Claim 15 is objected to because: "converting the failed fax pages into secondary email packets for re-transmission thereof to the recipient fax machine" how the secondary email packets can be retransmission to the recipient fax machine when the secondary email packets is the failed fax pages. Regarding the objection for the limitation in claim 15, the Examiner is respectfully referred to at least the three example sections in the previous two paragraphs.

It is respectfully submitted that the objections are overcome as pointed out by the sections of the detailed description above, and applicant respectfully requests they be withdrawn.

Claim Rejections – 35 USC § 103

Claims 1-18 are rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 6,023,345 to Bloomfield ("Bloomfield") in view of U.S. Pat. No. 6,219,150 B1 to Eguchi ("Eguchi").

Regarding claims 1, 3-4, 15, and 17-18

Claim 1 requires, in part, a router for... converting the first email message packets *to original fax pages* of a fax document, for *transmitting the original fax pages to a recipient fax machine* and upon failure to successfully transmit all of the pages of the fax document to the recipient fax machine, transmitting failed fax pages, defined by those fax pages of the fax document that failed to be successfully transmitted to the recipient fax machine, in the form of a secondary email message comprising secondary email packets, to the mail server for future retransmission of the failed faxed pages to the recipient fax machine.

Bloomfield discusses a facsimile to e-mail communication system with local interface, whereby a hardcopy document is sent via a fax device to its recipient via electronic mail, such that it can be retrieved by an e-mail device in the ordinary course of retrieving e-mail and displayed on the screen of the e-mail device. Bloomfield does not teach a router for converting the first email message packets *to original fax pages*, as well as the other similar limitations in claim 1.

Eguchi discusses a communications terminal device having an electronic mail function for reproducing a single original image even if it receives a plurality of electronic mails. Eguchi receives email image data and combines it for printing. Eguchi therefore does not cure the deficiencies of Bloomfield.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

Applicants respectfully submit that Bloomfield, even in view of Eguchi, does not teach or suggest all the claim limitations, and that claim 1 is patentably distinguishable over the prior art. Furthermore, by including the limitation of having the router convert the email data back to fax data, both Bloomfield and Eguchi would be unsatisfactory for their intended purposes. Claims 2-6, and 8-14, are dependent claims from claim 1. Since dependent claims necessarily contain the limitations of claims from which they depend, claims 2-6, and 8-14 are also patentably distinguishable over the prior art.

Claim 7 is a method that requires, in part, converting the first email message packets *into fax pages of a fax document*; transmitting the *fax pages to a recipient fax machine*. Claim 7 therefore requires similar limitations to claim 1, and applicants respectfully submit that Bloomfield, even in view of Eguchi, does not teach or suggest all the claim limitations, and that claim 7 is patentably distinguishable over the prior art.

Claim 15 is a method that requires, in part, converting the first email message packets *into first fax pages of a fax document*, and transmitting the *first fax pages to a recipient fax machine*. Claim 15 therefore requires similar limitations to claims 1 and 7, and applicants respectfully submit that Bloomfield, even in view of Eguchi, does not teach or suggest all the claim limitations, and that claim 15 is patentably distinguishable over the prior art. Claims 16 and 17, are dependent claims from claim 15. Since dependent claims necessarily contain the limitations of claims from which they depend, claims 16 and 17 are also patentably distinguishable over the prior art.


Claim 18 is a Beauregard claim containing essentially the same limitation as method claims 7 and 15, that is, it provides instructions in a computer readable medium for performing converting the first email message packets *into fax pages* of a fax document, and transmitting the *fax pages to a recipient fax machine*. Applicants therefore respectfully submit that Bloomfield, even in view of Eguchi, does not teach or suggest all the claim limitations, and that claim 18 is patentably distinguishable over the prior art.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-18 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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I hereby certify that this correspondence
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Submitted:


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